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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,511	08/22/2003	Masamoto Ito	0505-1218P	8759

2292 7590 12/17/2004

BIRCH STEWART KOLASCH & BIRCH  
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FALLS CHURCH, VA 22040-0747

EXAMINER
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SHRIVER II, JAMES A

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/645,511

Applicant(s)

ITO ET AL.

Examiner

J. Allen Shriver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. **Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Claim 7 recites the limitation "said accessory storage box guard member" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Examiner assumes that claim 7 should be dependent upon claim 4 instead of claim 3.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 3, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (US Patent 6,269,896 B1).** Tanaka et al. discloses an air guide device (See Fig. 1) for a vehicle comprising a chassis frame (6); an engine (4,5) being mounted on said chassis frame; and an engine guard (1) being arranged near said engine and protruding from the engine and the chassis frame spaced apart toward a side of the chassis frame so as to protect the engine, wherein an inner side of said engine guard is formed with an inclined surface opposing an exterior surface of said engine (See Fig. 2, where section 12 of the guard 1 has inclined surfaces which face the engine); **[claim 3]** wherein said engine guard has an irregular-shaped cross sectional surface (See Fig. 2, wherein the cross section of the guard is irregular); **[claim 5]** wherein said engine guard is formed by molding (See column 3, lines 8-12, where the guard is made from plastic that is known to be made from a molding process); **[claim 8]** further comprising an air passage being formed between said engine guard and said engine (See Fig. 1, where an air passage is formed between the engine guard and the engine).

6. **Claims 2, 4, 9-12 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Sako (US Patent 6,336,579 B1).** Sako discloses an air guide device for a vehicle comprising a vehicle main body having a chassis frame (F) and an engine (Eu); an accessory storage box (B) being secured to a rear side of said vehicle main body; and an accessory storage box guard (C, See Fig. 5) being arranged near said accessory storage box, said accessory storage box guard being spaced apart from the accessory storage box to protect the accessory storage box and protruding from a side of the chassis frame, wherein an inner side of said accessory storage box guard is formed with a flat surface (See Fig. 5) opposing said accessory storage box and forming an air passage between said accessory storage box and said accessory storage box guard; **[claims**

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**4 and 11-12]** wherein said accessory storage box guard has an irregular-shaped cross sectional surface (See Fig. 5).

Regarding claim 9, Sako discloses an air guide device for a vehicle comprising a vehicle main body having a chassis frame (F) and an engine (Eu); an accessory storage box (B) being secured to a rear side of said vehicle main body; and an accessory storage box guard (C, See Fig. 5) being arranged near said accessory storage box, said accessory storage box guard being spaced apart from the accessory storage box to protect the accessory storage box and protruding from a side of the chassis frame, wherein an inner side of said accessory storage box guard is formed with a flat surface (See Fig. 5) opposing said accessory storage box; and an engine guard (C) being arranged near said engine and protruding from the engine and the chassis frame spaced apart toward a side of the chassis frame so as to protect the engine, wherein an inner side of said engine guard at the chassis frame is formed with an inclined surface opposing an exterior surface of said engine (although Sako does not specifically show an inclined surface facing the engine, the cover is customarily formed in an aero-dynamic shape around the motorcycle, which would inherently include an inclined surface which would oppose the engine); **[claim 10]** wherein said engine guard has an irregular-shaped cross sectional surface (See fig. 1); and **[claim 16]** wherein said chassis frame is a motorcycle chassis frame (See Fig. 1).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 6-7 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sako (US Patent 6,336,579 B1) in view of Examiner's Official Notice.** Sako discloses the air guide device as set forth above, but does not specifically disclose wherein said engine guard and said accessory storage box guard is formed by molding. Examiner takes Official Notice that it is notoriously old and well known that motorcycle body covers/fairings are made from plastics or composite materials, which are produced from a molding process. Therefore, it would have been obvious to a person of ordinary skill in this art to form the engine guard and the accessory storage box guard from a molding process in Sako. The motivation for doing so would have been to be able to mass-produce the accessory storage box guard through a molding manufacturing process.

### ***Conclusion***

9. The prior art made of record in the accompanying PTO Form 892 and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Allen Shriver whose telephone number is (703) 308-1224. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris P. Ellis can be reached on (703) 305-0168. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

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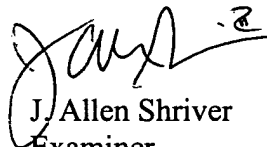
As of May 1, 2003, any response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to: (703) 305-3597 or (703) 305-7687 (for formal communications intended for entry. (703) 746-3852 (for informal communications directly to the Examiner).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Friday, December 10, 2004

 12/10/04  
J. Allen Shriver  
Examiner  
Art Unit 3618

JAS